

REMARKS

The 112 Rejection of Claim 1

The examiner rejects claim 1 as being indefinite under 35 U.S.C. 112, second paragraph. Specifically, the examiner asserts that the limitation “determining rate-constraint and corresponding frame count values sufficient to send desired signaling information from a radio access network (RAN) to a mobile station in a number of rate-constrained voice frames using dim-and-burst signaling” in claim 1 is indefinite because according to the examiner “it only requires the ability to perform.”

The examiner’s interpretation of the claim is at odds with the plain language of the claim, because the claim explicitly requires the step of determining rate-constraint and corresponding frame count values—there is nothing optional about that step. The “sufficient to” language simply specifies that the actual values determined for rate-constraint and frame count depend on the particulars of the signaling information that is to be sent—e.g., a large amount of signaling will require greater rate constraint and/or frame count than a small amount of signaling.

The examiner is reminded that “only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.” Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004). The meaning of claim 1 is clear on its face—the claimed method explicitly requires determining rate-constraint and frame count values and the disputed “sufficient to” language does not make that step optional or only something that is capable of being performed. Rather, the disputed language does no more than make clear that the rate-constraint and frame count values depend on the signaling to be sent. The indefiniteness rejection made against claim 1 is plain legal error and must be withdrawn.

The 112 Rejection of Claim 58

The examiner rejects claim 58 as being indefinite under 35 U.S.C. 112, second paragraph. Specifically, the examiner asserts that the use of “adapted to” in one of the limitations of claim 58 means that the limitation is not required, but rather “only requires the ability to perform” the recited limitation.

Simply put, the examiner’s rejection is grounded on the idea that “adapted to” language is never patentably limiting. That idea is legally wrong, as “adapted to” language is commonly used in patent claims, and is widely accepted both in the Patent Office and in the courts. For example, Section 2111.04 of the MPEP explicitly acknowledges that “adapted to” claim language is not *per se* non-limiting. More particularly, the MPEP advises examiners that any argument made against “adapted to” claim language must be based on a “facts and circumstances” analysis. Adopting the position that the use of “adapted to” means no more than the “ability to perform,” as the examiner does in the outstanding rejection, is erroneous and at odds with the explicit guidance given by the MPEP.

More pointedly, in 2001 the Board of Patent Appeals and Interferences overturned an examiner arguing that “adapted to” was never limiting. Ex Parte Ralph B. Brick, 2001 WL 1738852 (Bd. Pat. App. & Interf.) Specifically, the Brick examiner argued that “adapted to” means “able to perform” and that “it did not impart a limitation in any patentable sense.” In supporting this argument, the Brick examiner cited In re Hutchinson, 33 C.C.P.A. 879, 154 F.2d 135, 69 U.S.P.Q. 138 (C.C.P.A. 1946). In overturning the rejections, the Board in Brick stated (emphasis added):

The examiner’s determination that claims 1 through 11 and 13 are indefinite for these reasons is not well taken. The “adapted to be” terminology in the claims constitutes functional language which merely defines the claimed packaging assembly elements in terms of what they are intended to do. Contrary to the position taken by the examiner, there is nothing intrinsically wrong with the use of this technique in drafting a patent claim.

Further, in 1976 the Court of Customs and Patent Appeals held that “adapted to” language as used in the claims at issue imposed definite, structural limitations by limiting the recited structure to configurations that allow for the claimed functions to be performed. In re Venezia, 530 F.2d 956, 189 U.S.P.Q. 149 (C.C.A.P. 1976). Venezia has been cited by the District Courts and by the Federal Circuit for its “adapted to” holding, and Venezia remains good law today. See, e.g., Pac-Tec, Inc. v. Amerace Corp., 903 F.2d 796, 801, 14 U.S.P.Q.2d 1871 (Fed. Cir., 1990) (noted that “adapted to” constituted structural limitations); Elkay Mfg. Co. v. Ebcо Mfg. Co., 192 F.3d 973, 979, 52 U.S.P.Q.2d 1109, (Fed. Cir. 1999) (noting that “adapted to fit on the upper portion” of a cabinet imparts a structural limitation to the removable mounting means); and Intel Corp. v. Via Technologies, Inc., 319 F.3d 1357, 1365-1366, U.S.P.Q.2d, (Fed. Cir., 2003) (noted that computer logic adapted to perform a function represents the corresponding structure for the functions recited).

With the above points of law in mind, the examiner commits plain legal error by rejecting claim 58 simply because it includes the term “adapted to.” The rejection is not well taken and must be withdrawn.

The 112 Rejections of claims 13, 27, 28, and 47

Applicant amends claim 13 to read “a Public Switched Telephone Network” rather than “the Public Switched Telephone Network.” The same change is made to claim 47, and both claims 13 and 47 now should be acceptable to the examiner.

Applicant also amends claim 28 to refer to claim 26 rather than claim 25. That change in dependency cures the antecedent problem with “the timer” in claim 28. Applicant notes that Examiner errs by stating that claim 27 does not have antecedent basis for “the timer.” In any case, Applicant did find the timer antecedent problem in claim 29, and has corrected that claim.

With the above corrections, Applicant believes that all 112 formalities are addressed.

That is, Applicant believes that all 112 issues are addressed for all independent and dependent claims, and that all claims rejected under 112 now stand in condition for allowance.

The 102 Rejection of claim 58

The examiner states that claim 58 is anticipated under 35 U.S.C. 102(e) by Lee (2005/0026642). Lee relates to controlling the power of a packet data channel for a mobile station in handoff between two BSSs (base station systems). Lee has no relevance to the limitations of claim 58.

Specifically, the examiner cites Lee only because the examiner completely ignores the limitation of claim 58 that includes the phrase "adapted to." When that limitation is considered, as it must under the controlling law, Lee obviously does not anticipate the invention of claim 58 and the anticipation rejection must be withdrawn as a matter of law.

Further, Applicant notes that the effective date of Lee is its May 2000 foreign filing date only if that foreign application supports the claims in the later U.S. filing, whose date is 17 August 2004, well after Applicant's 2001 filing date. If 35 U.S.C. 112 support for Lee's U.S. claims is lacking in the foreign application, Lee is an inappropriate rejection reference by virtue of its filing date.

Conclusion

The indefiniteness rejections of claims 13, 27, 28, and 47 are addressed herein. The indefiniteness rejections of claims 1 and 58 are not well taken as a matter of law and must be withdrawn. The anticipation rejection of claim 58 fails on its face when claim 58 is given proper construction and thus must be withdrawn. Thus, all pending claims stand in condition for immediate allowance and Applicant looks forward to an indication as such by the examiner.

Respectfully submitted,

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